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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,141	09/24/2003	Sean Michael Kane	1676 US	7391
24289	7590	10/16/2006		
Mallinckrodt Inc. 675 McDonnell Boulevard PO Box 5840 St. Louis, MO 63134			EXAMINER DELCOTTO, GREGORY R	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/670,141

Applicant(s)

KANE ET AL.

Examiner

Gregory R. Del Cotto

Art Unit

1751

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-12 and 27.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Gregory R. Del Cotto
Primary Examiner
Art Unit: 1751

Continuation of 3. NOTE: Applicant's newly submitted amendment raises issues not previously presented which would require further consideration and/or search. Specifically, for example, Applicant has amended claims 2 and 14 such that the range of component (d) is from 25% to about 75% by weight which was not previously presented and would require further consideration and/or search. Additionally, the Examiner asserts that the specification, as originally filed, provides no basis for an upper limit of 75% by weight of component d) as recited by instant claims 2 and 14; thus, the Examiner asserts that this is new matter.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not sufficient to overcome the rejection(s) as set forth in the Office action mailed 8/2/06 which have been maintained for the reasons of record. Note that, Applicant once again states that every specific composition disclosed in the examples of Koito et al contains water and that Koito et al clearly show that when there is little water in their compositions, the compositions do not provide suitable strippability. In response, note that, the Examiner maintains that the broad teachings of Koito et al suggest compositions which are non-aqueous as recited by the instant claims. Additionally, the Examiner maintains that while compositions exemplified by Koito et al in Table 1 and Table 8 containing 4% water and 1% water, respectively, may possess some unsuitable properties, compositions containing 19% water and 70% water in Table 1 and 35% water in Table 8 also possess unsuitable properties so it is unclear if the unsuitable properties are attributable to the amount of water or other components present in the compositions. Furthermore, even compositions which are unsuitable with respect to certain properties are suitable with respect to other properties. Note that, all compositions prepared in the Tables presented by Koito et al fall within the scope of the compositions disclosed by Koito et al and are intended as suitable stripping compositions overall. Furthermore, Koito et al state in paras. 177 and 178 that the water content of the compositions found in Table 8 is optimal and desirable. Additionally, Applicant has presented no data showing the unexpected and superior properties of the claimed invention in comparison to those compositions falling outside the scope of the instant claims.